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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,457	10/09/2001	Erez Braun	109362	8069

7590 02/23/2005
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EXAMINER

LAM, ANN Y

ART UNIT PAPER NUMBER

1641

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,457

Applicant(s)

BRAUN ET AL.

Examiner

Ann Y. Lam

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on December 10, 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 42-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 84 is/are allowed.
- 6) Claim(s) 42-47 and 49 is/are rejected.
- 7) Claim(s) 48 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/11/04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Art Unit: 1641

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Noppe et al., 5,491,098.

Noppe disclose a method for depositing gold at one or more sites on a substrate (column 3, lines 34-35, and column 4, line 43 and 47), comprising:

(a) providing nucleation centers (i.e., gold marker, column 4, line 43 and 47) at said one or more sites, wherein said nucleation centers are each coupled to a first member (i.e., binding counterpart, column 3, line 49-50) of a recognition group additionally comprising at least a second member (specific binding agent, column 3, line 47) capable of binding to the first member of the recognition group, wherein the second member of the recognition group includes or forms said one or more sites, and is bound to the first member of the recognition group said nucleation centers being selected from the group consisting of a metal particle, a cluster containing metal atoms, a metal-containing complex and molecules containing metal atoms (i.e., developer containing

Art Unit: 1641

metal ions, specifically gold ions, column 3, line 51; column 5, line 3; and column 16, lines 22-23)

(b) providing a treatment composition (i.e., developer containing gold ions, column 3, line 51; column 5, line 3; and column 16, lines 22-23) which comprises a soluble gold-providing agent and is kinetically stable so that gold is not deposited unless a nucleation center is present; and

(c) contacting under appropriate conditions said one or more sites with the treatment composition whereby gold atoms are released from said gold-providing agent and deposited onto said nucleation center to form gold metal deposits at said one or more sites (column 3, lines 50-51.)

As to claim 43, the first member of the recognition groups is coupled to at least one nucleation center, the nucleation center being one or more of the group consisting of: cluster containing metal atoms and metal containing complexes and metals (column 3, lines 46-50; column 5, line 33.)

As to claim 44, the one member of the recognition group is coupled to at least one nucleation center, wherein the nucleation center is one or more of the group consisting of gold particle, cluster containing gold atoms and gold-containing complexes and molecules (column 3, line 49-50; column 4, line 43 and 47.)

As to claim 45, the one member of the recognition group is coupled to at least one nucleation center, the nucleation center being one or more of the group consisting of cluster containing gold atoms and gold-containing complexes and molecules (column 3, line 49-50; column 4, line 43 and 47.)

Art Unit: 1641

As to claim 46, said recognition group is a member of the group consisting of: a receptor and a ligand (column 5, line 33.)

As to claim 47, said treatment composition is an aqueous solution (column 3, line 38; column 4, line 13.)

As to claim 49, said reagent is hydroquinone (column 5, line 8.)

Allowable Subject Matter

Claim 48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 84 is allowed.

Response to Arguments

Applicant's arguments filed December 10, 2004 have been fully considered but they are not persuasive. Applicant argues that Noppe et al. does not teach a soluble gold-providing agent that is also kinetically stable. Examiner maintains that the Noppe et al. gold-providing agent is kinetically stable since it is in a stable solution (col. 5, lines 5-7) and provides gold ions for deposition (col. 3, line 51, col. 16, lines 22-23, and 47-48.)

Art Unit: 1641

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/1641

2/19/05